

(a) Express provisions of MPEP.02 notwithstanding, Examiner has failed to describe how he proposes to modify the teachings of Pitel -- by incorporating therein certain parts of Cox's teachings -- in such exact manner as to attain the claimed invention.

In supporting his rejections, Examiner states that:

"Cox discloses that the operating frequency of the inverter can be at or higher than the resonant frequency of the LC circuit so as to provide for the necessary high voltage required for starting the lamp".

Applicant can not find where Cox so discloses.

Perhaps Examiner means to refer to Cox's statement at column 5, lines 31-35? --- which statement follows:

"the resonant frequency of this circuit must be of the same order of magnitude as the operating frequency of the overall oscillator circuit under load conditions which should [sic] be from about 1/2 to 1 1/2 times the overall oscillator frequency".

Apparently, Examiner means to propose to modify Pitel in such manner as to somehow attain the feature described by the above-quoted statement by Cox.

However, if that indeed be what Examiner means, he be obliged to "set forth" a modification of Pitel that would in fact result in that feature being incorporated therein.

However, Examiner has utterly failed to "set forth" such a proposed modification.

In this connection, Applicant informs Examiner to the effect that -- according to Webster's Ninth New Collegiate Dictionary -- the term "set forth" means "set out into view"; which, in instant context, clearly means that Examiner must present his proposed modification in such manner as to be "set out into view"; which must mean that his proposed modification must be capable of being seen and understood by a person having ordinary skill in the particular art pertinent hereto.

Since Examiner utterly failed to so present his hinted-at proposed modification of Pitel, his rejections are invalid.

Moreover, Applicant informs Examiner to the effect that Pitel's Oscillator Ballast Circuit self-oscillates at the natural resonance frequency of its associated LC circuit. In contrast, the oscillating frequency of Cox's Inverter Oscillator Circuit is not determined by the natural resonance frequency of its associated LC circuit. So, how exactly would Examiner propose to rearrange Pitel's circuit so as to endow it with the non-resonant oscillating feature of Cox? --- As Applicant's sees it, Cox's circuit is simply not compatible with Pitel's circuit.

(b) And then comes the question of WHY.

That is, even if he could, WHY would a skilled artisan wish to modify Pitel's circuit in such particular manner as to attain the claimed invention? --- What would motivate him to seek to do that? --- What benefit would he expect to attain?

In other words, express provisions of MPEP 706.02 notwithstanding, Examiner failed to provide an explanation as to why a skilled artisan would find it obvious to modify Pitel's teachings in just such a manner as to attain the claimed invention.

More particularly, Examiner failed to show that the applied references would suggest to a skilled artisan that there be a benefit associated with modifying Pitel -- by incorporating certain aspects of Cox's teachings -- in such a way as to attain the claimed invention.

{Curiously, irrespective of what be suggested by the applied references, as Examiner sees it, what beneficial improvement over what Pitel already represents might result by modifying Pitel in such particular manner as to attain the claimed invention? --- and, where and/or how is this benefit suggested?}

By failing to show suggestion and/or to provide explanation, Examiner deprives Applicant of due process, leaving Applicant to guess as to what might motivate a skilled artisan to seek to modify Pitel's teachings, thereby preventing Applicant from doing a proper analysis and evaluation of Examiner's rejection.

(c) In holding claims 1, 8-12 and 19-27 as representing nothing but obvious modifications of Pitel's teachings, Examiner inherently also holds that effectuating his proposed modifications of Pitel's teachings (such as to attain Applicant's claimed invention) obviously do not result in any collateral consequences of such nature as to negate the benefits sought by the proposed modifications in the first place.

Thus, unless it be obvious to the skilled artisan that a given modification will not lead to consequences of such nature as to negate any sought-after benefit, the skilled artisan would not find this given modification to be one that he obviously would effectuate. For him to actually effectuate some given modification, such modification must clearly not cause collateral consequences of such nature as to negate whatever benefit he might otherwise have expected from the modification.

{Which, of course, is not to say that he might not consider it obvious to try to effectuate this modification. However, as is well established in case law, "obvious to try" is not a proper criterion on basis of which to hold a claimed invention obvious under 35 USC 103.}

Thus, in the absence of clear evidence to the effect that no collateral consequences (of such nature as to negate the sought-after benefit) will likely result, it is improper for Examiner to hold the invention defined by claims 1, 8-12 and 19-27 to be unpatentable under 35 USC 103.

CONCLUDING REMARKS

New claim 28, which depends from claim 25, stipulates that:


"a DC voltage of absolute magnitude higher than the peak absolute magnitude of the power line voltage".

This feature is neither described nor suggested by Pitel and/or Cox.

New claim 29, which depends from claim 11, stipulates that:

"the absolute magnitude of the DC voltage is higher than the peak absolute magnitude of the power line voltage".

This feature is neither described nor suggested by Pitel and/or Cox.



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